

REMARKS

The November 20, 2003 Official Action has been carefully reviewed. In light of the amendments presented herewith and the following remarks, favorable reconsideration and allowance of the application are respectfully requested.

The Examiner has objected to claim 28 for containing a minor informality. The error has been corrected in accordance with the present amendment, thereby rendering this objection moot.

At page 3 of the Official Action, the Examiner has rejected claims 35 and 36 under 35 U.S.C. §112, first paragraph asserting that the specification allegedly does not provide adequate enablement for a method comprising culturing cells other than pluripotent stem cells at low density.

The Examiner has rejected claims 28, 33-36 and 40-43 under 35 U.S.C. §112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

The foregoing constitutes the entirety of the objections and rejections raised in the November 20, 2003 Official Action. In light of the present claim amendments and the following remarks, each of the above-mentioned rejections under 35 U.S.C. §§112, first and second paragraph is respectfully traversed.

**CLAIMS 35 AND 36 AS AMENDED FULLY COMPLY WITH THE REQUIREMENTS
OF 35 U.S.C. §112, FIRST PARAGRAPH**

Claims 35 and 36 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement for methods of culturing cells other than pluripotent stem cells at low density. The Examiner acknowledged that claims 35 and 36 were enabled for a method for screening for differentiation factors of cellular development comprising culturing pluripotent

embryonic stem cells at low density. Applicants have amended claims 35 and 36 to recite "culturing "pluripotent embryonic stem (ES) cells." In light of this amendment, Applicants respectfully request that the rejection of the claims for inadequate enablement be withdrawn.

**THE METES AND BOUNDS OF CLAIMS 28, 33-36 AND 40-43 AS AMENDED
ARE CLEAR TO ONE OF ORDINARY SKILL IN THE ART**

Claims 28, 33-36 and 40-43 were rejected as allegedly indefinite. Specifically, claims 28, 36 and 40-43 were rejected for reciting an intended use for the claimed method that is distinct from the intended use of the methods from which they depend but fail to set forth any method steps that would accomplish the intended use.

Claims 28, 33-36 and 41-43 have been amended to recite essential method steps. Applicants have cancelled claim 40.

The Examiner objected to claim 33 and dependent claim 34 because of a typographical error in claim 33 and alleged unclarity about which conditions in "a" are referred to by the detection step in "b". Applicants have corrected the error in claim 33 by deleting a semicolon. The claim has also been amended to specify the conditions to which the detection step of part "b" refers by stating that the method involves "detecting any differentiation of the cells and cell types generated, if any, in the presence of the modulator compared to differentiation and cell types generated in the absence of the modulator."

Claim 35 was rejected as indefinite in the recitation of "the cells" in the first line of part "a" because of an alleged lack of antecedent basis. The claim was also considered indefinite in the limitation "at low density" because it is unclear how the limitation applies to cell types other than ES cells. Claim 35 has been amended to recite

"culturing pluripotent embryonic stem (ES) cells" which overcomes both objections.

Applicants submit that any perceived lack of clarity has been rectified by the foregoing amendments. Accordingly, the rejection of claims 22, 33-36 and 40-43 for alleged indefiniteness is no longer applicable and should be withdrawn.

CONCLUSION

No new matter has been introduced into this application by reason of any of the amendments presented herewith. Moreover, none of the present claim amendments is believed to constitute a surrender of any originally claimed subject matter, or a narrowing of the claims in order to establish patentability. The effect of these amendments is merely to make explicit that which was implicit in the claims as originally worded.

In view of the present claim amendments, and the foregoing remarks, it is respectfully urged that the rejections set forth in the November 20, 2003 Official Action be withdrawn and that this application be passed to issue. In the event the Examiner is not persuaded as to the allowability of any claim, and it appears that any outstanding issues may be resolved through a telephone interview, the Examiner is requested to telephone the undersigned attorney at the phone number given below.

Respectfully submitted,

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